

Applicants : Ron S. Israeli et al.  
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prostate specific antigen having the amino acid sequence shown in SEQ ID NO: 2. The Examiner stated that this SEQ ID NO: 2 meets the written description and enablement provisions of 35 U.S.C. §112, first paragraph. The Examiner stated that however, the claims are directed to encompass a nucleic acid molecule (i.e. primer) that hybridize to the nucleic acid sequence encoding the prostate specific antigen having the amino acid sequence shown in SEQ ID NO: 2 or other sequence, which correspond to sequences from other species, mutated sequences, allelic variants, splice variants, sequences that have similarity or homology, and so forth. The Examiner stated that none of these nucleic acid molecule (i.e primer) or nucleic acid molecules encoding a prostate specific membrane antigen meet the written description provision of 35 U.S.C. §112, first paragraph.

The Examiner stated that Vas-Cath Inc V. Makurhar, 19 USPQ2d 1111, makes clear that applicants must convey with reasonable clarity to those skilled in the art, as the filing date sought, he or she was in possession of the invention. The invention is, for purpose of the written description inquiry whatever is now claimed (see page 1117). The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.

The Examiner stated that with the exception of SEQ ID No: 2, the skilled artisan cannot envision the detailed chemical structure of the encompassed polynucleotidies and therefore conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method of isolation. The Examiner stated that adequate written description requires more than a mere statement that is part of the invention and reference to a potential method for isolating it, The nucleic acid itself is required.

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In response, but without conceding the correctness of Examiner's position and to expedite the prosecution of the subject matter, applicants have hereinabove amended claims 90 and 93. Applicants haveinabove amended independent claims 90 and 93 to incorporate SEQ ID NO: 2.

Applicants maintain that all claimed the sequences have to be able to specifically hybridize with the nucleic acid molecule encoding a prostate specific membrane antigen having the amino acid sequence as set forth in SEQ ID NO:2, or the molecule complimentary to the molecule encoding a prostate specific membrane antigen having the amino acid sequence as set forth in SEQ ID NO:2. One said nucleic acid molecule which encodes a prostate specific membrane antigen was described in SEQ ID NO: 1, pages 103-106 in the specification. An ordinary skilled artisan is enabled by the specification to obtain the nucleic acid molecule of at least fifteen nucleotides which is capable of specifically hybridizing with SEQ ID NO: 2, or its complementary sequence. Applicants maintain that once the molecule to be hybridized is known, it will be a routine experiment to determine the molecule to hybridize.

Accordingly, in view of the foregoing, applicants respectfully request the reconsideration and withdrawal of this ground of rejection.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, except for FOUR HUNDRED AND SEVENTY FIVE DOLLARS (\$475.00) for a three-month extension of time is deemed necessary in connection with the filing of this Amendment. However, if any

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additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-1325.

Respectfully submitted,

Albert Wai Kit Chan

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Albert Wai Kit Chan

Albert Wai-Kit Chan  
Reg. No. 36,479

2/9/98  
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